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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,706	03/10/2004	Kuniharu Umeno	033036.075	4225

25461 7590 09/14/2005

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EXAMINER

HARRISON, MONICA D

ART UNIT	PAPER NUMBER
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2813

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

Office Action Summary

Application No.

10/797,706

Applicant(s)

UMENO ET AL.

Examiner

Monica D. Harrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-9 is/are rejected.
- 7) ☐ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/18/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 5-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Ota (6,376,101 B1).

2. Regarding claim 1, Ota discloses a resin composition for encapsulating a semiconductor chip comprising: an epoxy resin (A) (column 1, line 41); a phenol resin (B) (column 1, line 43); an inorganic filler (C) (column 1, line 47); a curing accelerator (D) (column 1, lines 47); a silane coupling agent (E) (column 6, lines 50-51); and Compound (F) containing two and more hydroxyl groups combined with each of adjacent carbon atoms comprising an aromatic ring (column 2, formula 2; column 9, formulas (h-2),(h-4) and (h-5)).

3. Regarding claim 2, Ota discloses wherein the resin composition comprises said compound (F) is more than or equal to 0.01 wt% (column 8, lines 37-50).

4. Regarding claim 3, Ota discloses wherein the resin composition comprises said silane coupling agent (E) in 0.01% wt to 1 wt% both inclusive (column 6, lines 20-34).

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5. Regarding claim 5, Ota discloses wherein said Compound (F) contains two hydroxyl groups combined with each of adjacent carbon atoms comprising said aromatic ring (column 2, formula 2; column 9, formulas (h-2), (h-4) and (h-5)).

6. Regarding claim 6, Ota discloses wherein the aromatic ring is a naphthalene ring (column 3, lines 13-25).

7. Regarding claim 7, Ota discloses wherein said Compound (F) contains two hydroxyl groups combined with each of adjacent carbon atoms comprising said naphthalene ring (column 3, lines 13-25).

8. Regarding claim 8, Ota discloses wherein the resin composition comprises said inorganic filler (C) in 80 wt% to 94 wt% both inclusive (column 6, lines 20-34).

9. Regarding claim 9, Ota discloses a semiconductor device wherein a semiconductor chip is encapsulated by the use of a resin composition for encapsulating a semiconductor chip according to Claims 1 (column 1, lines 10-19).

Allowable Subject Matter

10. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica D. Harrison whose telephone number is 571-272-1959. The examiner can normally be reached on M-F 7:00am-3:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Whitehead Jr. can be reached on 571-272-1702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Monica D. Harrison
AU 2813

mdh
September 2, 2005


DAVID BLUM
PRIMARY EXAMINER